

REMARKS

The final Office Action dated June 9, 2003, has been received and reviewed.

Claims 1-23 are currently pending in the above-referenced application. Each of claims 1-23 stands rejected.

Reconsideration of the above-referenced application is respectfully requested.

Claim Objections

Claims 5, 11, and 17 have been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 5, which recites “wherein said marking comprises: providing said energy-reactive marking material over said surface of said at least one semiconductor chip,” depends from independent claim 1 and further limits the act of “marking” in independent claim 1 by indicating how the energy-reactive marking material is provided, a feature which is not provided in independent claim 1.

Claim 11, which depends from independent claim 7, recites “wherein said exposing is effected without creating an imprint in said surface.” It is respectfully submitted that the subject matter recited in claim 11 further limits that of independent claim 7 by indicating that the acts of “marking” and “exposing” in independent claim 7 may be effected without creating an imprint in the surface of at least one semiconductor chip, a feature which is not recited in independent claim 7.

Claim 17, which depends from independent claim 13, includes language that is similar to that recited in claim 5 and further limits the subject matter of independent claim 13 in the same way that claim 5 further limits the subject matter of independent claim 1.

For these reasons, it is respectfully submitted that claims 5, 11, and 17 further limit the subject matter of the claims from which they depend. It is, therefore, respectfully requested that the objections to these claims under 37 C.F.R. § 1.75(c) be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Each of claims 1-23 stands rejected under 35 U.S.C. § 103(a).

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Folk in View of Meneghini

Claims 1-18 have been rejected under 35 U.S.C. § 103(a) for purportedly reciting subject matter which is unpatentable over that taught in U.S. Patent 4,594,263 to Folk (hereinafter "Folk"), in view of the teachings of U.S. Patent 5,757,313 to Meneghini et al. (hereinafter "Meneghini").

Folk teaches a process for marking semiconductor devices that have been packaged in metal. The process of Folk includes cleaning the surface of the metal package, using electroless plating techniques to form a nickel layer thereon, cleaning residual salts from the metal package and the nickel layer, and exposing the nickel to acid to convert it to an optically black form which is highly absorptive of laser energy. When marking is desired, such as when a semiconductor device package has been tested and it is determined that the semiconductor device is suitable for use, selected locations of the optically black coating on the nickel layer may be exposed to a laser to expose the underlying, shiny nickel at those locations, thereby forming a mark on the metal semiconductor device package.

Folk also teaches that these processes are far superior to the use of inks or other similar materials that must be cured, as such materials undesirably "involve several stages of handling" and results in marks that "may be removed by abrasion." Col. 1, lines 28-30.

Meneghini teaches inks that may be applied to various types of substrates, including microelectronic devices (col. 1, lines 12-15), and that are cured by laser irradiation. *Id.*

It is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) cannot be established against any of claims 1-18 based on the teachings of Folk and Meneghini. This is because Folk clearly teaches away from the asserted combination of teachings therefrom with ink-marking or polymer-marking teachings such as those of Meneghini.

Specifically, at col. 1, lines 25-31, Folk teaches that the use of ink and, presumably, other polymers, for marking is undesirable since several stages of handling may be required, cure times are required, and such marks may be removed from substrates.

As Folk teaches that the teachings thereof may not be combined with teachings of the type made in Menghini, it is respectfully submitted that the only way that one of ordinary skill in the art would have been motivated to combine the teachings of Folk and Menghini would have been from improper hindsight provided by the teachings of the above-referenced application.

It is, therefore, respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established against any of claims 1-18.

Folk in View of Meneghini, Purportedly Admitted Prior Art, and Corley

Claims 19-23 stand rejected under 35 U.S.C. § 103(a) for purportedly reciting subject matter which is unpatentable over the combination teachings from Folk, in view of teachings from Meneghini, purported prior art admissions that have been made in the above-referenced application (hereinafter "PPA"), and the teachings of U.S. Patent 5,256,578 to Corley et al. (hereinafter "Corley").

Claims 19-23 are allowable, among other reasons, as depending either directly or indirectly from independent claim 13, which is allowable.

It is further submitted that neither the PPA nor the teachings of Corley remedy the fact that Folk teaches away from the combination of teachings thereof with those of Menghini.

Therefore, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established against any of claims 19-23.

For these reasons, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 1-23 be withdrawn.

ENTRY OF AMENDMENT

Entry of this Amendment is respectfully solicited. It is respectfully submitted that the Amendment should be entered, as no claim amendments have been presented herein. Thus, this Amendment neither introduces new issues into the above-referenced application nor necessitates an additional search. Further, the explanations provided herein clearly delineate the issues that remain in the above-referenced application for purposes of appeal.

CONCLUSION

It is respectfully submitted that each of claims 1-23 is allowable. An early indication of the allowability of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



Brick G. Power
Registration No. 38,581
Attorney for Applicant
TRASKBRITT, PC
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: July 31, 2003

BGP/sls:djp
Document in ProLaw